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09/916,942	07/26/2001	Daniel C. Castle	10003069-1	8801

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

LAstra, DANIEL

ART UNIT	PAPER NUMBER
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3622

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07/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/916,942	Applicant(s) CASTLE, DANIEL C.	
	Examiner DANIEL LASTRA	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-16 have been examined. Application 09/916,942 (Method and apparatus for increasing on-line publication distribution) has a filing date 07/26/2001.

Response to Amendment

2. In response to Notice to the applicant regarding a Non-Compliant Amendment filed 04/05/2007, the Applicant filed an Amendment on 05/04/2007, which amended claims 1, 7-9, 15 and 16 .

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 7, 8, 9 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Said claims recite "if it is determined that the subscriber is a low frequency user, as determined by the number of publications sent to the subscriber and the number of times the publications were sent from empirical data sending the subscriber a list of publications related to any one or more that the subscriber already receives and a targeted content advertisement for the publication in which said targeted content advertisement is placed". Nowhere, in Applicant's specification is recited sending a subscriber a list of publications and also a

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targeted content advertisement. Applicant's specification has support for sending a subscriber a targeted content advertisement identified from a list of publications related to one or more that the subscriber already receives (see Applicant's specification page 8, lines 17-25).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 7, 8, 9 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recites sending the subscriber a list of publications related to any one or more that the subscriber already receives and a targeted content advertisement for the publication in which said targeted content advertisement is placed. For purpose of art rejection said limitation would be interpreted as sending a subscriber a targeted content advertisement obtained from a list of publications related to any one or more that the subscriber already receives.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard (US 2005/0091109) in view of Gardenswartz (US 6,298,330).

As per claims 1, 7 and 8, Howard teaches:

In an on-line publication ("publication") distributed to a plurality of publication subscribers via a data network, a method of sending to a publication subscriber, at least one of either: paid advertising messages or content advertising messages;

said method comprising the steps of:

reading from a server for said publication, a user profile for the subscriber (see Howard paragraph 8);

automatically tracking publication distribution to various receipt subscribers (see Howard paragraph 26), including recording times during the day that the subscriber requests files of the publications (see paragraphs 45, 46, 56);

determining the subscriber's publication usage levels from data in said user profile (see Howard paragraph 46), the recorded times, the files that the subscriber requested, whether the subscriber requested a download of a particular known type of file and the automatically tracked publication distribution, wherein the data includes historical data of the subscriber's usage of on-line publications (see paragraphs 36, 40 42);

sending the subscriber paid advertisement (see Howard paragraphs 50-51);

sending the subscriber *a list of publications related to any one or more that the subscriber already receives* and a targeted content advertisement for the publication for

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the publication in which said targeted content advertisement is placed (see Howard paragraph 59),

said targeted content advertisement being selected based upon at least one of:

data in said user profile (see Howard paragraph 59); and

advertising space available in said publication for content advertising usage (see Howard paragraph 52); and

including in said content advertisement a sample of the specified content and instructions as to how to receive said content (see paragraph 59);

detecting the subscriber's request for continued delivery of said specified content via said data network (see Howard paragraph 39) ;

modifying data in the user profile to reflect the subscriber's request for continued delivery of said specified content (see Howard paragraph 40).

Howard does not expressly teach that *if it is determined from historical usage level data that the subscriber that the subscriber is a high frequency user, sending the subscriber paid advertising and not sending additional online publications; if it is determined that the subscriber is a low frequency user, as determined by the number of publications sent to the subscriber and the number of times the publications were sent from empirical data sending the subscriber a list of publications related to any one or more that the subscriber already receives and a targeted content advertisement for the publication in which said targeted content advertisement is placed.* However, Gardenswartz teaches that it is old and well known in the promotion art to target advertisements to consumers in order that said consumers change existing behavior or

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continue an established behavior. Thus, for example a heavy user of a product (*i.e.* Brand X soda) would be targeted with alternative product advertisements (*i.e.* Brand Z soda) in order to provide said user an incentive to switch to another product (see Gardenswartz col 15, lines 30-50). Also, Gardenswartz teaches that it is old and well known in the promotion art to avoid targeting ads to consumers with respect to products that said consumers are heavy users of said products but instead targeting said ads with respect to said products to consumers that are low frequency users of said products (see Gardenswartz col 17, lines 55-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that electronic publishers would be motivated to send new subscriptions' offers (*i.e.* targeted content advertisements) to low frequency users of electronic publications and would be motivated to send advertisements not related to subscriptions' offers to high frequency users of electronic publication in view that it is old and well known in the promotion art that the more loyal a user is toward a product the less need said user needs to be targeted with ads of said products, as taught by Gardenswartz.

As per claim 2, Howard teaches:

The method of claim 1 wherein said step of sending a targeted content advertisement is further comprised of the step of:

selecting a content advertisement for transmission to the user, the selection of which is based upon at least one of: data in said user profile; and advertising space available in said publication for content advertising usage (see paragraph 8).

As per claim 3, Howard teaches:

The method of claim 1 wherein said step of sending a targeted content advertisement is further comprised of the step of:

selecting a content advertisement for transmission to the user, the selection of which is based upon at least one of: data in said user profile; and advertising space available in said publication for content advertising usage (see paragraphs 8 and 59); and

including in said content advertisement, a sample of the specified content and instructions as to how to continue to receive said specified content via said publication (see paragraph 46).

As per claim 4, Howard teaches:

The method of claim 1 wherein said step of sending a targeted content advertisement is further comprised of the step of:

selecting a content advertisement for transmission to the user based upon said user profile and the advertising space available for content advertising usage (see paragraphs 8 and 59);

including in said content advertisement a sample of the specified content and instructions as to how to receive said content (see paragraphs 57-59);

assembling said content advertisement and said sample of the specified content into a data package and transmitting the data package to the subscriber via said data network (see paragraphs 57-59).

As per claim 5, Howard teaches:

The method of claim 1 further comprised of the steps of:

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detecting via said data network, the subscriber's request for continued delivery of said specified content via said data network (see paragraph 56);

modifying data in the user profile to reflect the subscriber's request for continued delivery of said specified content (see paragraph 56).

As per claim 6, Howard teaches:

The method of claim 1 further comprised of the steps of:

detecting via said data network, the subscriber's request for continued delivery of said specified content via said data network (see paragraph 56);

modifying data in the user profile to reflect the subscriber's request for continued delivery of said specified content (see paragraph 56);

monitoring the subscriber's usage levels of said publication (see paragraph 56).

As per claims 9, 15 and 16, Howard teaches:

In an on-line publication ("publication") distributed to a plurality of publication subscribers via a data network, a method of sending to a publication subscriber, at least one of either: paid advertising messages or content advertising messages;

said method comprising the steps of:

reading from a server for said publication, a user profile for the subscriber (see Howard paragraph 8);

automatically tracking publication distribution to various recipient subscribers (see Howard paragraph 26) including recording times during the day that the subscriber requests files of the publications (see paragraphs 45, 46, 56);

determining the subscriber's publication preferences from data in said user profile (see Howard paragraph 42), the recorded times, the files that the subscriber requested, whether the subscriber requested a download of a particular known type of file and the automatically tracked publication distribution, wherein the data includes historical data of the subscriber's usage of on-line publications (see paragraphs 36, 40 42);

sending the subscriber a targeted paid advertisement (see Howard paragraphs 50-51);

sending the subscriber a targeted content advertisement consistent with the subscriber's determined preferences (see Howard paragraph 59).

Howard does not expressly teach *if it is determined from historical usage level data that the subscriber that the subscriber is a high frequency user, sending the subscriber paid advertising and not sending additional online publications; if it is determined that the subscriber is a low frequency user, as determined by the number of publications sent to the subscriber and the number of times the publications were sent from empirical data sending the subscriber a list of publications related to any one or more that the subscriber already receives and a targeted content advertisement for the publication in which said targeted content advertisement is placed.* However, the same rejection applied to claim 1 regarding this missing limitation is also applied to claims 9, 15 and 16.

As per claim 10, Howard teaches:

The method of claim 9 wherein said step of sending a targeted content advertisement is further comprised of the step of

selecting a content advertisement for transmission to the user, the selection of which is based upon at least one of:

data in said user profile (see paragraph 59); and

advertising space available in said publication for content advertising usage (see paragraph 52).

As per claim 11, Howard teaches:

The method of claim 9 wherein said step of sending a targeted content advertisement is further comprised of the step of:

selecting a content advertisement for transmission to the user, the selection of which is based upon at least one of:

data in said user profile (see paragraph 59); and

advertising space available in said publication for content advertising usage (see paragraph 52); and

including in said content advertisement a sample of the specified content and instructions as to how to receive said content (see paragraph 59).

As per claim 12, Howard teaches:

The method of claim 9 wherein said step of sending a targeted content advertisement is comprised of the step of:

selecting a content advertisement for transmission to the user based upon at least one of:

data in said user profile (see paragraph 59); and

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advertising space available for content advertising usage (see paragraph 59);
and

including in said content advertisement a sample of the specified content and
instructions as to how to receive said content (see paragraph 59);

assembling said content advertisement and said sample of the specified content
into a data package and transmitting the data package to the subscriber (see paragraph
44).

As per claim 13, Howard teaches:

The method of claim 9 further comprised of the steps of:

detecting the subscriber's request for continued delivery of said specified content
(see paragraph 39);

modifying data in the user profile to reflect the subscriber's request for continued
delivery of said specified content (see paragraph 40).

As per claim 14, Howard teaches:

The method of claim 9 further comprised of the steps of:

detecting the subscriber's request for continued delivery of said specified content
(see paragraph 39);

modifying data in the user profile to reflect the subscriber's request for continued
delivery of said specified content (see paragraph 39);

monitoring the subscriber's usage levels (see paragraphs 36, 46).

Response to Arguments

5. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

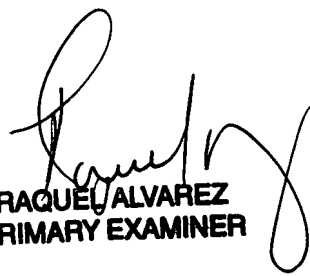
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra
July 15, 2007



RAQUEL ALVAREZ
PRIMARY EXAMINER